

A3 20. (New) The method for on-line viewing of an article on another structure, according to claim 9, wherein the structure is an apparel-wearable model, and the selected article is apparel.

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated September 19, 2002, indicated that claims 1-17 stand rejected under §103(a) as being unpatentable over *Rajaraman et al.* (U.S. Pat. No. 6,366,910) and *Jacobi et al.* (U.S. Pat. No. 6,317,722).

Applicant respectfully traverses the §103(a) rejection because the Office Action fails to present a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness, the Office Action must present a teaching of prior art references so as to provide complete correspondence to the claimed invention and evidence of motivation for combining the prior art references as asserted. The Office Action fails to meet each of the requirements.

The Office Action fails to present references which completely correspond to the claimed invention. The Office Action fails to identify where the '722 reference teaches a host site and where the '722 reference teaches an article-provider site as claimed. It appears that in the '722 reference only one site is referred to as corresponding to both the claimed host-site and the claimed article-provider site. As both of these sites are not present in the '722 reference, the '722 reference also fails to teach limitations directed to the host-site being, "web-linkable to at least one article-provider site."

The Office Action also fails to present a reference that teaches or suggests Applicant's claimed structure. The instant invention is directed to a method for on-line viewing of an article on another structure including, *inter alia*, limitations directed to "linking the on-line viewer to the host-site and selecting a structure in response to a command received by the on-line viewer." In an attempt to show correspondence to Applicant's claimed structure, the Office Action erroneously cites the shopping cart of the '722 reference. The shopping cart of the '722 reference, "keeps track of items that have

been selected by a user for possible purchase.” The claimed structure of the instant invention is a foundational image to be merged with an identified article. (*See*, Specification page 5, lines 5 and 13-15). The ‘722 reference makes no mention that the shopping cart is an image. The shopping cart as taught by the ‘722 reference clearly fails to correspond to Applicant’s claimed structure.

Furthermore, the ‘722 reference fails to teach generating a new image by forming an image of a merged item including representations of both the structure and an article as claimed. Neither cited FIG. 5 or FIG. 6 shows a new merged image. At best, FIG. 5 would generate a merged list, which does not correspond to the claimed image. There is no discussion in the cited portions of the ‘722 reference regarding merging representations to form a new image as claimed.

Another example of the Office Action’s failure to present correspondence between the references and the instant invention is at page 2, where the Office Action acknowledges that the ‘722 reference fails to teach that the images from the article provider sites are images of the articles themselves as claimed, for example, in claim 1. In an attempt to overcome this deficiency, the Office Action points to FIGs. 1A and 1B of the ‘910 reference. Neither of these figures show an image from an article-provider site as claimed. The images in boxes 101-104 are mascots indicating four departments of the ‘910 reference (*see*, col. 3, lines 62-65). Further, the cited portions of the ‘910 reference make no mention of passing images from an article provider site and instead teach viewing, “detailed information about the classification” and “displays information describing the items within that classification.” (col. 4, lines 47 and 51-52).

With respect to the remaining claims, the Office Action fails to present references that completely correspond to the claimed invention. Specifically regarding claims 2-3, the cited portions of the ‘910 reference make no mention of size or style codes. With specific respect to claims 11-13, the cart of the ‘722 reference does not correspond to Applicant’s claimed invention as discussed above, and further no correspondence has been asserted between the cart of the ‘722 reference and the host-site as directed in claims 11-13. With respect to claims 14-15, Applicant is unsure as to which reference is being asserted to correspond to the claims. Each of the claims in the instant application include limitations

directed to the above-discussed aspects and therefore, the §103 rejection should fail with respect to each of the claims.

The Office Action also fails to present evidence of motivation in support of the modification of the cited '722 reference. Evidence has not been provided of any teaching or suggestion for using the '722 reference in connection with a host-site which is web-linkable to an article-provider site, as claimed in the instant invention, or for modifying the reference to achieve the claimed limitations. Recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000). The Office Action fails to identify evidence of why one skilled in the art would be led to modify the '722 reference, and does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Applicant requests that the rejection be withdrawn.

Moreover, one skilled in the art would not modify the '722 reference with the teachings of the '910 reference. The Examiner's proposed modification would clearly undermine the purpose of the '722 reference, which is to generate personalized recommendations of similar items based on the collective interests of a community without the need for the user, or any other users, to rate the items, thereby permitting the viewer (customer) to purchase alternative or additional items of the same type. Using this approach, the viewer (customer) is given an opportunity to review data and/or the link for each such similar item separately. In order to review these different items separately, they must be viewable separately for selection separately.

The proposed modification to the '722 reference, however, would place the generated list of the '722 reference into a small data set representing a "shopping cart." (Col. 5, lines 25-27). There is no purpose for moving the generated list as shown in FIG.

6 into a “shopping cart.” As the “shopping cart” is a smaller data set than the presentation of FIG. 6, moving the list into the “shopping cart” would render the list indecipherable and therefore, illegible. To allege under §103 that a skilled artisan would read the ‘722 reference in such a manner is untenable and impermissible under §103. *See, e.g., In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (A §103 rejection cannot be maintained when the asserted modification undermines the purpose of main reference.)

Even after the Examiner’s proposed modification is implemented, the resulting combination would fail to correspond to all of the limitations of the claimed invention. The claimed invention involves, among other aspects, combining images of articles to view a composite image. The proposed modification is not motivated, is improper, and would not achieve the claimed invention. As such, the §103 rejection should be withdrawn.

The above discussion presented in connection with the cited prior art merely sets forth reasons as to why the rationale presented in the Office Action fails to align and correspond the cited prior art with the invention as claimed. No amendments regarding patentability were made to the claims with respect to these references and it is believed that, after a careful review of the cited art, no arguments should be required to explain why the cited art is significantly different from the claimed invention. New claims 18-20 merely manifest Applicant’s “long-accepted right to press alternative claims covering different aspects of ... [Applicant’s disclosed] invention.” *Amgen, Inc. v. Hoechst Marion Roussel*, 126 F. Supp.2d 69 (D. Mass. 2001). The amendment of “the” to “a” in each of claims 1 and 4 merely expresses that which is already impliedly present, and therefore, is not an issue of patentability. *Ex parte Porter*, 25 U.S.P.Q.2d 1144, 1145 (Bd. Pat. App. & Inter. 1992). Applicant respectfully submits that, by way of this Office Action Response, there is no intention to narrow, nor has the Applicant narrowed, the breadth of the claims as originally filed through the explanatory comments provided herein.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance.

Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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